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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,975	10/24/2000	Avi Nelson	VTZON-005XX	1367
207	7590	10/06/2003	EXAMINER	
WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP TEN POST OFFICE SQUARE BOSTON, MA 02109			JAMAL, ALEXANDER	
			ART UNIT	PAPER NUMBER
			2643	3

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/694,975

Applicant(s)

NELSON, AVI

Examiner

Alexander Jamal

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 24 October 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.                      6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 14, 15** rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- a. **Claim 14:** Applicant's claim describes the keyboard as being in the second operative mode (off-hook with a connection established) and still being operable to answer a call placed on the phone line. It is not possible to answer a second call on the phone line without having the keyboard leave the second operative mode.

- b. **Claim 15:** As claim 15 depends upon rejected claim 14, it is also rejected.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. **Claims 1-5, 7-13, 16-25** rejected under 35 U.S.C. 102(b) as being anticipated by Kessler (4503288).

- a. **Claim 1:** Kessler discloses an alphanumeric keyboard 10 (Fig. 1) that is connectable to a telephone line (ABSTRACT). The keyboard is operative to generate dialing signals on the telephone line as keys of the keyboard are pressed (Col 2 lines 49-55)
- b. **Claim 2:** Kessler's keyboard generates telephone number dialing signals in a first mode of operation in which it behaves a standard 'ma-bell' telephone (Col 18 lines 40-41). It operates in a second mode of operation to generate alphanumeric character code signals on a telephone line via the keys of the keyboard (Col 2 lines 6-13).
- c. **Claim 3:** Kessler's keyboard is able to operate in a 'data terminal mode' in which the device is in a first operating mode (telephone number dialing) while the user has the handset in an off-hook condition and no connection to the telephone line has been established. Once a connection has been established the keyboard enters into the second operating mode (alphanumeric character code generation) to allow the user to communicate with the host computer system (Col 10 lines 18-35).
- d. **Claim 4:** Kessler's keyboard is disposed within a common housing with a telephone device as seen in Fig. 1.
- e. **Claim 5:** Kessler's keyboard may enter said first or second operating modes in response to an indication from the user (Col 17 lines 13-34).
- f. **Claim 7:** Kessler's keyboard utilizes ASCII codes as the alphanumeric character codes (Col 2 lines 6-13).

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- g. Claim 8:** Kessler's keyboard comprises a display 36 (Fig. 1) (Col 1 line 65 to Col 2 line 1).
- h. Claim 9:** In Kessler's keyboard, the display 36 (Fig. 1) is operable to display all incoming and outgoing data, which would include any telephone numbers dialed out (generated on the telephone line) (Col 1 line 65 to Col 2 line 1).
- i. Claim 10:** In Kessler's keyboard, the display 36 (Fig. 1) is operable to display all incoming and outgoing data, which would include any alphanumeric characters codes (represented by alphanumeric characters) sent out (generated on the telephone line) (Col 1 line 65 to Col 2 line 1).
- j. Claim 11:** Kessler's keyboard comprises display 36 (Fig. 1), memory (Col 8 lines 60-65), and microprocessor (Col 3 lines 19-24).
- k. Claim 12:** Kessler's keyboard is operable (in a third operating mode) to accept a message entered by the user via the keyboard keys, store the message in memory, and send out the message to the phone line while the keyboard is in the second mode of operation (Col 20 line 56 to Col 21 line 6).
- l. Claim 13:** Kessler's keyboard is operable to automatically enter an 'on-hook' state when the local telephone device is in an on-hook condition, just like a standard telephone (Col 2 lines 49-55). While in the on-hook mode the keyboard is in the third mode of operation where alphanumeric characters may be entered in for dialing and messaging (Col 20 line 56 to Col 21 line 6).
- m. Claim 16:** Kessler's keyboard comprises an interface to a printer (Col 2 lines 6-13).

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- n. **Claim 17:** Kessler's keyboard is operative to accept and store a user-entered telephone number in memory, then dial a sequence of telephone numbers upon the user's request while the phone is in a first operating state (Col 10 lines 36-46).
- o. **Claim 18:** Kessler's keyboard is operable to receive a message on the line, store the message in memory, and display the message to the user upon request (Col 18 lines 25-35).
- p. **Claim 19:** Kessler discloses that his keyboard operates in as a standard telephone, which inherently can dial dual-tone multi-frequency signals in order to be compatible with the existing telephone infrastructure.
- q. **Claim 20:** Kessler discloses that his keyboard operates as a standard telephone, which inherently can dial pulse signals in order to be compatible with the existing telephone infrastructure.
- r. **Claim 21:** In Kessler's disclosed keyboard:
  - i. Telephone dialing digits may be associated with respective decimal digits (Col 2 lines 62-64).
  - ii. Telephone dialing digits 31 (Fig. 1) may be associated with respective sets of letter characters (Col 2 line 65 to Col 3 line 3).
  - iii. Telephone dialing digits are generated by pressing the appropriate letter or number characters on the keyboard (Col 2 line 62 to Col 3 line 3).
- s. **Claim 22:** In Kessler's disclosed keyboard:

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- i. Telephone dialing digits may be associated with respective decimal digits (Col 2 lines 62-64).
- ii. Telephone dialing digits 31 (Fig. 1) may also be associated with respective sets of letter characters (Col 2 line 65 to Col 3 line 3).
- iii. Telephone dialing digits are generated by pressing the appropriate letter or number characters on the keyboard (Col 2 line 62 to Col 3 line 3).
- t. **Claim 23:** Kessler discloses that his keyboard operates in as a standard telephone, which inherently can dial dual-tone-multi-frequency signals (which are associated with a multi-frequency tone set) in order to be compatible with the existing telephone infrastructure.
- u. **Claim 24:** Kessler discloses that his keyboard operates in as a standard telephone, which inherently can dial dual-tone multi-frequency signals in order to be compatible with the existing telephone infrastructure.
- v. **Claim 25:** In Kessler's disclosed keyboard:
  - i. Telephone dialing digits 31 (Fig. 1) may be uniquely associated with respective sets of letter characters (Col 2 line 65 to Col 3 line 3).
  - ii. Telephone dialing digits are generated by pressing the appropriate letter character on the keyboard (Col 2 line 62 to Col 3 line 3).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 6** rejected under 35 U.S.C. 103(a) as being unpatentable over Kessler (4503288).

a. **Claim 6:** Kessler's keyboard is operable to make operating mode indications via the use of a button or buttons. However, Kessler does not specify the use of a switch to make operating mode indications.

The examiner takes official notice that it is notoriously well known in the art that a switch may be used in lieu of a button. Based upon this information, it would have been obvious to one of ordinary skill in the art at the time of this application that either a button or switch could be used in making operating mode indications in order to provide the users with an easy method of inputting information to the keyboard.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 703-305-3433. The examiner can normally be reached on M-F 8AM-5PM.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A Kuntz can be reached on 703-305-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9315 for After Final communications.

AJ  
September 22, 2003

  
**DUC NGUYEN**  
**PRIMARY EXAMINER**